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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Nicholas Gerard Byrne *et al.*

Confirmation No.: 4931

Serial No.: 09/857,456

Group Art Unit: 1473

Filed: September 24, 2001

Examiner: To be assigned

For: INTERFACE PATCH CLAMPING

Attorney Docket No.: 11285-005-999

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### INFORMATION DISCLOSURE STATEMENT

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

In accordance with the duty of disclosure provisions of 37 C.F.R. §1.56, there is hereby provided certain information which the Examiner may consider material to the examination of the subject U.S. patent application. It is requested that the Examiner make this information of record if it is deemed material to the examination of the application.

1. Enclosures accompanying this Information Disclosure Statement are:

1a. ☒ A list of all patents, publications, applications, or other information submitted for consideration by the office.

1b. A legible copy of:

- ☒ Each U.S. patent application publication and U.S. and foreign patent;
- ☒ Each publication or that portion which caused it to be listed on the PTO-1449;
- ☐ For each cited pending U.S. application, the application specification including the claims, and any drawing of the application, or portion of the application which caused it to be listed on the PTO-1449 including any claims directed to that portion;
- ☐ all other information or portion which caused it to be listed on the PTO-1449.

1c. ☒ An English language copy of search report(s) from a counterpart foreign application or PCT International Search Report.

1d. ☒ Explanations of relevancy (ATTACHMENT 1(d), hereto) or English language abstracts of the non-English language publications.

2. ☒ This Information Disclosure Statement is filed under 37 C.F.R. §1.97(b):

- ☐ Within three months of the filing date of a national application other than a continued prosecution application under §1.53(d);

- ☐ Within three months of the date of entry of the national stage as set forth in §1.491 in an international application;
  - ☒ Before the mailing of the first Office action on the merits;
  - ☐ Before the mailing of a first Office action after the filing of a request for continued examination under §1.114.
3. ☐ This Information Disclosure Statement is filed under 37 C.F.R. §1.97(c) after the period specified in 37 C.F.R. §1.97(b), but before the mailing date of any of a final action under 37 C.F.R. §1.113, a notice of allowance under 37 C.F.R. §1.311 or an action that otherwise closes prosecution in the application.

*(Check either Item 3a or 3b)*

- 3a. ☐ The Certification Statement in Item 5 below is applicable. Accordingly, no fee is required.
- 3b. ☐ The \$180.00 fee set forth in 37 C.F.R. §1.17(p) in accordance with 37 C.F.R. §1.97(c) is:
- ☐ enclosed
  - ☐ to be charged to Pennie & Edmonds LLP Deposit Account No. 16-1150.

*(Item 3b to be checked if any reference known for more than 3 months)*

4. ☐ This Information Disclosure Statement is filed under 37 C.F.R. §1.97(d) after the period specified in 37 C.F.R. §1.97(c), but on or before the date of payment of the issue fee.

The \$180.00 fee set forth in 37 C.F.R. §1.17(p) is:

- ☐ enclosed.
- ☐ to be charged to Pennie & Edmonds LLP Deposit Account No. 16-1150.

The Certification Statement in Item 5 below is applicable.

5. ☐ Certification Statement *(applicable if Item 3a or Item 4 is checked)*

*(Check either Item 5a or 5b)*

- 5a. ☐ In accordance with 37 C.F.R. §1.97(e)(1), it is certified that each item of information contained in this Information Disclosure Statement was first cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement.
- 5b. ☐ In accordance with 37 C.F.R. §1.97(e)(2), it is certified that no item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to the knowledge of the undersigned after making reasonable inquiry, was known by any individual designated in 37 C.F.R. §1.56(c) more than three months prior to the filing of this Information Disclosure Statement.
6. ☐ This application is a continuation application under 37 C.F.R. §1.60 or §1.53(b) or (d).

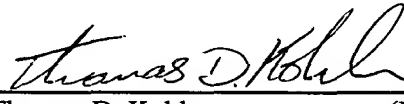
*(Check appropriate Items 6a, 6b and/or 6c)*

- 6a. ☐ A Petition to Withdraw from issue under 37 C.F.R. §1.313(b)(5) is concurrently filed herewith.
- 6b. ☐ Copies of publications listed on Form PTO-1449 from prior application Serial No. \_\_\_, filed on \_\_\_, of which this application claims priority under 35 U.S.C. §120, are not being submitted pursuant to 37 C.F.R. §1.98(d).
- 6c. ☐ Copies of the publications listed on Form PTO-1449 were not previously cited in prior application Serial No. , filed on , and are provided herewith.
7. ☐ This is a Supplemental Information Disclosure Statement. *(Check either Item 7a or 7b)*
- 7a. ☐ This Supplemental Information Disclosure Statement under 37 C.F.R. §1.97(f) supplements the Information Disclosure Statement filed on \_\_\_. A bona fide attempt was made to comply with 37 C.F.R. §1.98, but inadvertent omissions were made. These omissions have been corrected herein. Accordingly, additional time is requested so that this Supplemental Information Disclosure Statement can be considered as if properly filed on \_\_\_.
8. ☐ In accordance with 37 C.F.R. §1.98, a concise explanation of what is presently understood to be the relevance of each non-English language publication is:
- ( Check Item 8a, 8b, or 8c)*
- 8a. ☐ satisfied because all non-English language publications were cited on the enclosed English language copy of the PCT International Search Report or the search report from a counterpart foreign application indicating the degree of relevance found by the foreign office.
- 8b. ☐ set forth in the application.
- 8c. ☐ enclosed as an attachment hereto.
9. ☒ The Commissioner is authorized to charge any additional fee required or credit any overpayment for this Information Disclosure Statement and/or Petition to Pennie & Edmonds LLP Deposit Account No. 16-1150.

10. ☒ No admission is made that the information cited in this Statement is, or is considered to be, material to patentability nor a representation that a search has been made (other than a search report of a foreign counterpart application or PCT International Search Report if submitted herewith). 37 C.F.R. §§1.97(g) and (h).

Respectfully,

Date: March 26, 2003

  
Thomas D. Kohler (Reg. No.) 32,797  
PENNIE & EDMONDS LLP  
3300 Hillview Avenue  
Palo Alto, CA 94304  
(650) 493-4935

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Sheet 1 of 1

# LIST OF REFERENCES CITED BY APPLICANT

(Use several sheets if necessary)

ATTY DOCKET NO.

11285-005-999

APPLICATION NO

09/857,456

APPLICANT

Nicholas Gerard Byrne *et al.*

FILING DATE

September 24, 2001

GROUP

1743

## U.S. PATENT DOCUMENTS

*EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
	A01	4,897,426	1/30/1990	Llinas <i>et al.</i>			
	A02	5,225,374	7/6/1993	Fare <i>et al.</i>			
	A03	5,234,566	8/10/1993	Osman <i>et al.</i>			
	A04	5,643,796	7/1/1997	Van den Engh <i>et al.</i>			
	A05	5,981,268	11/9/1999	Kovacs <i>et al.</i>			
	A06	6,063,260	5/16/2000	Olesen <i>et al.</i>			

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## FOREIGN PATENT DOCUMENTS

		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION
	A07	WO89/01159	27/7/1988	PCT			
	A08	WO96/36436	25/4/1996	PCT			
	A09	WO97/20203	21/11/1996	PCT			
	A10	WO97/25616	13/1/1997	PCT			
	A11	WO98/23948	26/11/1997	PCT			
	A12	WO99/19729	09/10/1998	PCT			
	A13	WO99/66329	14/6/1999	PCT			
	A14	WO00/34776 A1	06/12/1999	PCT			
	A15	WO01/71349	21/3/2001	PCT			
	A16	WO01/94939	6/6/2001	PCT			

## OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, Etc.)

A17	Anderson, M.T. <i>et al.</i> , "Simultaneous fluorescence-activated cell sorter analysis of two distinct transcriptional elements within a single cell using engineered green fluorescent proteins," Proc. Natl. Acad. Sci USA, Vol. 93, pp. 8508-8511 (1996)
A18	Brew, Helen <i>et al.</i> , "Electrogenic glutamate uptake is a major current carrier in the membrane of axolotl retinal glial cells," Nature, Vol. 327, pp. 707-709 (1987)
A19	Fu, Anne Y. <i>et al.</i> , "A microfabricated fluorescence-activated cell sorter," Nature Biotechnology, Vol 17, pp. 1109-1111 (1999)
A20	O.P. Hamill <i>et al.</i> , "Improved Patch-Clamp Techniques for High-Resolution Current Recording from Cells and Cell-Free Membrane Patches," Plugers Archiv., European Journal of Physiology, pp 85-100 (1981)
A21	"Lecture 5: Electrophysiological Techniques," BIOL 445 - 1997 Notes on the WWW.
A22	Margolskee, Robert F., <i>et al.</i> , "Panning Transfected Cells for Electrophysiological Studies," Research Report - BioTechniques, Vol. 15, No. 5, pp. 906-911 (1993)
A23	Sheng, Morgan, "PDZs and Receptor/Channel Clustering: Rounding Up the Latest Suspects," Neuron, Vol. 17, pp. 575-578 (1996)
A24	Stephens, Gary J. <i>et al.</i> , "On the mechanism of 4-aminopyridine action on the cloned mouse brain potassium channel mKv1.1," Journal of Physiology, pp. 187-196 (1984)
A25	Winegar, Bruce, "Obtaining Gigohm Seals" Eleusis Patch Clamp Resources (1999)

EXAMINER

DATE CONSIDERED

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.